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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,385	12/04/2000	Steven J. Harrington	D/A0657	7423

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/733,385	Applicant(s) HARRINGTON, STEVEN J.	
	Examiner Matthew J. Ludwig	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed 11/18/05.
2. Claims 1-20 are pending in the application. Claims 1, 3-9, 12, 13, 18, and 19, are independent claims.
3. Claims 1, 2, and 8, remain rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Furthermore, claims 1-8, 18, 19, and 20, remain rejected under 35 U.S.C. 102(e) as being anticipated by Nielson. Claim 12 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Katariya in view of Nielson and claims 9-11 and 13-17 remain rejected under Katariya in view of Sandford.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-2, and 8 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.**

The claims are not directed to statutory subject matter because the claimed subject matter merely recites stored data that describes a document processing system. As presently claimed, the quantitative values related to intents of a design of the document and indicative of relative importance of document properties related to the design fail to provide or produce a useful, concrete, and tangible result. Furthermore, the claim describes a document; however, the claim seems to be missing the essential steps to provide a tangible result. Finally, the amendment made

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to the claims, which state *operative to process documents described in a data format* fails to describe or produce a tangible result and accomplish a practical application. In order for a claimed invention to accomplish a practical application, it must produce a “useful, concrete, and tangible result” *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (see MPEP 2106.II.A). Currently, the claim does not recite a practical application. In order for the claimed product to produce a “useful, concrete, and tangible” result, recitation of one or more of the following elements is suggested:

- The manipulation of data that represents a physical object or activity transformed from outside the computer (MPEP 2106 IVB2(b)(i)).
- A physical transformation outside the computer, for example in the form of pre or post computer processing activity (MPEP 2106 IVB(b)(i)).
- A direct recitation of a practical application in the technological arts (MPEP 2106 IVB2(b)(ii)).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-8, 18, 19, and 20, are rejected under 35 U.S.C. 102(e) as being anticipated by Nielson et al., USPN 6,810,143 filed (10/26/2004).**

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In reference to independent claim 1, Nielson teaches:

Provides color management procedures in assigning where color management functions are to be performed with respect to a particular document. Furthermore, the reference discloses rendering intent information. See column 4, lines 14-56. The output of the application is document data, which is associated by color management function with a document complexity metric. The intent information is utilized to define the design of the document and more particularly, the color profile. See column 4, lines 25-53. The profile inherently forms a type of intent component. Finally, the output of application is document data, which is associated by color management function with a document complexity metric. Document complexity metric comprises one or more values that are required for the color management functions to determine where the color management actions are to be performed with respect to document data. See column 3, lines 45-67. The metric provides a quantitative value related to intents of a design of the document and indicative of relative importance of document properties related to the design.

In reference to dependent claim 2, Nielson teaches:

Document complexity metric comprises one or more values that are required for the color management functions to determine where the color management actions are to be performed with respect to document data. See column 3, lines 45-67. The metric provides a quantitative value related to intents of a design of the document and indicative of relative importance of document properties related to the design.

In reference to independent claim 3, the limitations comprise instructions used for performing similar methods as claimed in independent claim 1, and in further view of the following, is rejected along the same rationale. Furthermore, no weight could be given to the term intent

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capture capabilities. The Examiner provides the intent information within the Nielson to provide the teaching of something that could be capable, within a document processing system, to carry out quantitative processes.

In reference to independent claim 4, Nielson teaches:

Provides color management procedures in assigning where color management functions are to be performed with respect to a particular document. Furthermore, the reference discloses rendering intent information. See column 4, lines 14-56. The output of the application is document data, which is associated by color management function with a document complexity metric. The intent information is utilized to define the design of the document and more particularly, the color profile. See column 4, lines 25-53. The profile inherently forms a type of intent component.

In reference to independent claim 5, Nielson teaches:

Provides color management procedures in assigning where color management functions are to be performed with respect to a particular document. Furthermore, the reference discloses rendering intent information. See column 4, lines 14-56. The output of the application is document data, which is associated by color management function with a document complexity metric. The intent information is utilized to define the design of the document and more particularly, the color profile. See column 4, lines 25-53. The profile inherently forms a type of intent component.

In reference to claims 6-8, 18, 19, and 20, the claims reflect the system comprising instructions used for performing the methods as claimed in 1-3, and in further view of the following, are rejected along the same rationale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katariya et al., USPN 6,549,897 filed (12/17/98) in view of Nielson et al., USPN 6,810,143 filed (10/26/2004).**

In reference to independent claim 12, Figure 1 of Katariya discloses a document indexing and retrieval system [110], for storing documents [100] described in a data format including document data [102] and quantitative document intent information [114], including a document storage device [Memory 111]; a document indexing system (Col. 5 line 45), indexing documents in accordance with quantitative document intent information [114]; a document retrieval system, retrieving document [115, 116]. The reference does not explicitly state document intent information representing intents of a design of the documents and being maintained to be used in decisions made to output the documents; however, Nielson provides intent information used within a document data environment. It would have been obvious to one of ordinary skill in the art, having the teachings of Katariya and Nielson before him at the time the invention was made, to modify the document processing methods of Katariya, because it would have given a user the added benefit of having a reduction of intercommunication.

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10. Claims 9-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katariya et al., USPN 6,549,897 filed (12/17/98) in view of Sandford, USPN 6,021,196 filed (5/26/98).

In reference to independent claim 9, Combination of Katariya et al. and Sandford, II et al. discloses a document creation system, creating a document described in a data format including document data (Katariya, Fig. 1 [102]) and quantitative document intent information (Katariya, Fig. 1 [114c]), including a user interface (Sandford, Fig. 1 [10a]), at which document data (Sandford Fig. 1 [10]) and quantitative document intent information may be entered and displayed (Sandford, Col. 4 lines 9-10); a document editor (Sandford, Fig. 1 [11-14], generating and applying document data (Sandford, Fig. 1 [10]) and quantitative document intent information to a stored document file (Sandford, Fig. 1 [15], Col. 4 lines 12-18); a document formatter (Sandford, Fig. 1 [12, 13a]), using said document data (Sandford, Fig. 1 [10]) and quantitative document intent information to format the document, for subsequent display at said user interface (Sandford, Fig. 1 [10a], Col. 4 lines 9-22).

It would be obvious to one having ordinary skill in the art at the time the invention was made to have incorporated Sandford's formatted values into Katariya's quantitative values for the purpose of processing the publication quality digital image in order to modify its quality (Col. 3 lines 32-33).

Regarding dependent claim 10, combination of Katariya and Sandford as applied to claim 9 above, Figure 1 of Sandford discloses wherein said display at said user interface interactively occurs during document creation (Col. 4 lines 1-22).

Regarding dependent claim 11, combination of Katariya and Sandford as applied to claim 9 above, Figure 1 of Sandford discloses wherein during document creation, said user interface displays examples [10a] of the effects of examples of quantitative document intent information [steps 11-15], which examples are selectable [13a and 12] via said user interface to there apply said quantitative document intent information (Col. 4 lines 1-22).

Regarding independent claim 13, Combination of Katariya et al. and Sandford, II et al. discloses a method of formatting (Sandford, Fig. 1) a document for use at a document using device, wherein the document includes document data (Katariya, Fig. 1 [101]) and (Sandford, [10 digital image data]) and document intent information (Katariya, Fig. 1 [114c]) and (Sandford, [Truecolor-format image], Col. 4 lines 4-5), said document intent information provided as a set of quantitative values indicative (Katariya, Fig. 1 [114c]) and (Sandford, Col. 4 line 9) of relative importance of document properties (Katariya, Col. 2 lines 24-29) and (Sandford, Col. 4 lines 9-22); said document using device using the formatted document (Sandford, Fig. 1 [13a, 12]) in accordance with said document usage capabilities and quantified intents (Sandford, Fig. 1 [11-15]); and said document formatting (Sandford, Fig. 1 [13a, 12]) for said document using device depending on said document intents (Sandford, Fig. 1).

Regarding dependent claim 14, combination of Katariya and Sandford as applied to claim 13 above, Figure 1 of Sandford discloses wherein said formatting provides a closest possible match (see [13a, 12] and [10a], they are closest possible match) between effective quantified intents of the formatted documents [13a and 12], formatted for said document using device [11-15] and said document intent information (Sandford, [Truecolor-format image], Col. 4 lines 4-5).

Regarding dependent claim 15, combination of Katariya and Sandford as applied to claim 14 above, Figures 2A, 2B, and 3 of Sandford discloses wherein said effective quantified intents are calculated from measurable intent properties of said formatted document (Sandford, Col. 5 lines 32-56).

Regarding dependent claim 16, combination of Katariya and Sandford as applied to claim 15 above, Figure 1 of Sandford discloses wherein said measurable intent properties of said formatted documents [13a and 12] depend on formatting decisions resulting [10a] from document intent information of the document (Col. 4 lines 4-22).

Regarding dependent claim 17, combination of Katariya and Sandford as applied to claim 13 above, Fig. 1 of Sandford discloses where the measurable intent properties ([Truecolor image pixel color component values] Col. 4 lines 9-12) are dependent on the document device ([11, 12] Col. 4 lines 4-10).

Response to Arguments

11. Applicant argues on page 7 of the applicant's response that, without any admission or concession on the correctness of the examiner's position, the amendment to claims 1, 2, and 8 overcomes the 35 U.S.C. 101 rejection. The examiner disagrees and has adjusted the 35 U.S.C. 101 rejections pursuant to applicant's amendment. Furthermore, the applicant argues on page 7 of the amendment that Nielson fails to include the feature of intents which indicate the relative importance of *each* document's properties. The examiner fails to see such a limitation within the independent claim. The examiner cannot argue a limitation that is not found in the independent claim. Applicant states that Nielson's patent relates to a single property which a document

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possesses, color. The Nielson reference states a document data file that is larger than a threshold value and requires more than four channels or more than one transform, its complexity dictates that the color management actions be carried out by the print driver. See column 6, lines 5-19. The threshold value dictates the importance of the intent component and design of the document. The term *relative importance*, as presently claimed, is vague and fails to preclude the examiner from utilizing a threshold value to determine the relative importance of the color management actions be carried out by the print driver. The phrase document properties are a broad term and include a wide a range of possibilities when the claim is read as a whole by the examiner. Finally, the examiner strongly believes the phrase *relative importance* fails to distinguish the claim from the prior art reference to Nielson.

In reference to applicant's arguments regarding claims 3-7 and 18-20, the reference provides multiple examples of intent information used in the processing of document data. The Nielson reference states a document data file that is larger than a threshold value and requires more than four channels or more than one transform, its complexity dictates that the color management actions be carried out by the print driver. See column 6, lines 5-19. The threshold value dictates the importance of the intent component and design of the document. Therefore, it would have given the user a proficient means for document processing based upon specific document data characteristics.

The applicant argues on page 9 of the amendment that claim 12 is not obvious because the Examiner's references do not recite "document intent information representing intents of a design of the documents and being maintained to be used in decisions made to output the documents. However, the intent information or rendering intents taught by Nielson are based

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upon a threshold value that determines whether or not the color management actions be carried out by the print driver. This process could be included in the intent information component of the invention and therefore, provides a proficient suggestion of information used in decisions made to output documents. See column 5, lines 1-13. If the intent information were based off of a threshold value, then it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the information stored in decisions made to output the document via a print server.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

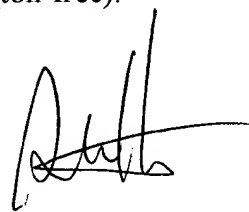
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
January 31, 2006



STEPHEN HONG
SUPERVISORY PATENT EXAMINER